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Second, Applicants respectfully request that the Examiner acknowledge Applicants' claim for priority in the next communication. Please refer to Applicants' letter of March 15, 2001, submitted concurrently with the filing of this application. In that letter, on page 2, Applicants claimed the right to priority based on Japanese Application No. 200-200134, filed June 30, 2000. A certified copy of that Japanese Application was also filed at that time.

Turning to the Office Action dated June 18, 2003, the Examiner rejected claims 1, 4-6, and 16 under 35 U.S.C. § 102(e) as being anticipated by Henderson et al. (U.S. Patent No. 6,526,333) and rejected claims 9-10 and 13-15 under 35 U.S.C. § 103(a) as being unpatentable over Henderson. Finally, the Examiner objected to claims 2-3, 7-8, 11-12, and 17-18 as being dependent upon a rejected base claim, but indicated these claims would be allowable if rewritten in independent form including all of the elements of each claim's base claim and any intervening claims. Applicants appreciate the Examiner's indication of allowable subject matter in this application. Claims 1-18 are pending in the application.

Applicants respectfully traverse the rejection of claims 1, 4-6, and 16 as being anticipated by Henderson for the following reasons. To properly anticipate Applicants' claimed invention, each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2121 (8th ed., Aug. 2001), *quoting*

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, “[t]he elements must be arranged as required by the claim.” M.P.E.P. § 2131 (8th ed. 2001), p. 2100-69.

Claim 1 recites a combination including, among other things, “instructing a replacement of a fan module” and “turning off the fan drive voltage when the replacement is instructed.” Henderson does not anticipate at least these features of Applicants’ claimed invention.

By contrast, Henderson discloses a cooling system for cooling components of a computer. See Abstract. As disclosed by Henderson, a method of operating a plurality of fans of a first speed involves sensing the operation of the plurality of fans to ensure that each of the plurality of fans is operating at the first speed, determining that at least one of the plurality of fans is operating at a speed other than the first speed, and inducing the fans other than the at least one fan to operate at a second speed. Such a change is made to at least partially offset the loss of cooling capacity caused by the fan operating at a speed other than the first speed. See col. 3, lines 2-13. Henderson thus involves regulating fan speeds for a plurality of fans and compensating for fans not operating at a sufficient speed.

In the Office Action, pages 2-3, the Examiner alleges “the claimed instructing replacing of a fan module is met” by col. 7, lines 45-55, and that “the claimed controlling a fan drive voltage and the claimed turning off the voltage when replacement is instructed is met” by col. 8, lines 11-39. Applicants respectfully disagree with these allegations for the following reasons.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

First, Henderson discloses at col. 7, lines 45-55, that control system 200 monitors the speed of rotation of a number of fans when the fans are operating a first speed. When microprocessor 230 determines that one of the fans is no longer operating, the microprocessor can then increase the voltage to the remaining operating fans to thereby increase the speed of operation of the remaining fans 202. See col. 7, lines 47-51. Accordingly, Henderson does not anticipate at least "instructing a replacement of a fan module" as recited in claim 1. Instead, Henderson discloses increasing voltages to a plurality of fans that were already in operation.

Second, Henderson discloses at col. 8, lines 11-39, that if the speed of fan 202 is not above a desired limit, then the fan is not operating properly. In that case, microprocessor 230 can determine whether the fan speed is equal to zero. See col. 8, lines 11-16, for example. Henderson therefore does not anticipate at least "turning off the fan drive voltage when the replacement is instructed" as recited in claim 1. Instead, Henderson discloses monitoring a fan drive's voltage to allow "a maintenance person to identify which fans are not operating correctly for subsequent replacement and/pr repair" (emphasis added). See col. 8, lines 36-39. Applicants therefore respectfully request that the Examiner withdraw the rejection for at least these reasons and allow claim 1.

Dependent claims 4 and 5 depend from allowable claim 1 and are allowable at least for the same reasons as discussed above regarding allowable claim 1. Applicants respectfully request that the Examiner withdraw the rejection of claims 4 and 5 and allow the claims.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Additionally, the Examiner has used the same rationale to reject claims 6 and 16. Claim 6 recites a combination including, among other things, "means for controlling a fan drive voltage that turns off the fan drive voltage supplied to a fan module to be replaced when the replacement is instructed." As discussed above, Henderson does not disclose at least these features of Applicants' claimed invention.

Claim 16 recites a combination including, among other things, "means for controlling a fan drive voltage via the relay cable that turns off the fan drive voltage supplied to a fan module to be replaced when the replacement is instructed." Henderson does not disclose at least these features of Applicants' claimed invention. Nor has the Examiner shown that each and every element of claim 16 has been found, either expressly or inherently, in a single prior art reference, as is required to establish a *prima facie* case of anticipation.

Because claims 6 and 16 include recitations of a similar nature to allowable claim 1, Applicants respectfully request that the Examiner allow these claims for at least the reasons discussed above in relation to allowable claim 1.

Applicants respectfully traverse the rejection of claims 9-10 and 13-15 as being unpatentable over Henderson for the following reasons. To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

Applicants' claim 9 recites a combination including, among other things, "a relay cable coupled to a fan module for transmitting the fan drive voltage." Applicants' claim 10 recites a combination including, among other things, "wherein the replay cable is capable of being disconnected/connected from/to a fan module." Henderson does not disclose or suggest at least these features of Applicants' claimed invention.

Moreover, the Examiner admits that Henderson does not disclose or suggest all of these features. See Office Action, page 3. The Examiner then alleges the "use of relay cables which are connectable/disconnectable and are coupled to fan modules for providing voltage is well known in the art." See Office Action, page 3. Additionally, the Examiner alleges "it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate some form of cable for providing power, since this would have been the most reliable and as well safety oriented means for providing proper voltages for operating the fans." See Office Action, page 3.

These allegations by the Examiner are unsubstantiated by any factual evidence in the record, such as a competent prior art reference. In addition, the Examiner has not accounted for any evidence of success for making such a modification of the teachings of Henderson. Nor has the Examiner provided any motivation arising within Henderson suggesting such a modification for such alleged purposes of reliability and safety. Therefore, in the absence of such a prior art reference, lack of motivation, and

lack of any showing of success, a *prima facie* case of obviousness has not been made and the Examiner should withdraw the rejection of claims 9 and 10 for at least these reasons.

Regarding claims 13-15, the Examiner alleges the recited subject matter was met as discussed regarding claim 6 and that "the claimed means for controlling including a switch and software are met" citing col. 8, lines 1-50. As discussed above, Henderson does not disclose all of the features recited in Applicants claim 6, from which claims 13- and 15 depend. Therefore, claims 13-15 are allowable at least for the reasons discussed above in relation to allowable claim 6. Applicants respectfully request that the Examiner withdraw the rejection of claims 13-15 and allow these claims.

Finally, regarding the objection to claims 2-3, 7-8, 11-12, and 17-18 as being dependent upon rejected base claims, Applicants respectfully request the allowance of these claims at least for the reasons set forth above regarding these claims' respective base claims. Claims 2-3, 7-8, 11-12, and 17-18 are allowable at least for the same reasons as set for above regarding allowable independent claims 1, 6, and 16. Therefore, Applicants respectfully request that the Examiner withdraw the objection to claims 2-3, 7-8, 11-12, and 17-18 and allow these claims.

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com